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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/849,284

05/19/2004

Arthur C. Fitzgerald

PA-04-005

6642

7590
Kenneth L. Milik
143 Martin Street
Carlisle, MA 01741

05/29/2008

EXAMINER

REYNOLDS, STEVEN ALAN

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

05/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/849,284	Applicant(s) FITZGERALD ET AL.	
	Examiner Steven Reynolds	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 90-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 90-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/18/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the reply filed on 3/18/2008. Claims 90-100 are pending.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the location of the folded and glued seam must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 90-100 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not sufficiently disclosed the folded and glued seam, in which the radio frequency identification tag is captured within. The structure or location of the folded and glued seam is not shown in Fig. 4 in relation to any other structures of the device. It is not known how the device is constructed. For purposes of examination, the folded and glued seam is construed to be any structure that can be considered a folded and glued seam on a storage container.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 90-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradford (US 5,908,135). Bradford discloses a storage container capable of storing documents, comprising a die cut container blank (24) folded and joined to form an enclosure capable of containing documents; the container having at least one folded seam (folded along score line 66 to form a two ply seam); and a radio frequency identification tag (104) captured within the joined portion of the seam. Bradford discloses the claimed invention except for the specific means for securing the container layers together.

Regarding the means for securing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have secured the layers together by glue instead of butt welding, as the two forms of securing are well known art-recognized equivalents.

Regarding the blank being die cut, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. (Same cite as above).

Regarding claims 91-99, Bradford discloses a storage container capable of being considered a file folder, file box, carton, envelope, package, jacket or a pocket, as there

is no corresponding structure claimed. The container of Bradford is capable of holding file folders and loose documents, since they are merely intended use and there is no specific structure corresponding to its use. Further regarding claim 98, the storage container of Bradford is capable of being considered an x-ray jacket, as it is clearly capable of holding x-ray film.

Regarding claim 100, Bradford discloses the claimed invention except for the printed identification information on the container. Official Notice is taken, that it is old and conventional to include printed information on the outer surface of a container in the form of a label. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the Official Notice to have provided the outer surface of the container of Bradford with printed information in the form of a label in order to easily identify the contents of the container.

Response to Arguments

7. Applicant's arguments filed 3/18/2008 have been fully considered but they are not persuasive. Regarding applicant's argument that has disclosed sufficient written description to allow one of ordinary skill in the art to make and use the claimed invention: while folding and gluing container blanks to create glued seams is known in the art, the specific location and structure of the folded and glued seams of the claimed invention is not disclosed by the original disclosure of the applicant. While applicant has cited patents which identify examples of document storage containers made from a

folded and glued blank, there is no support in applicant's disclosure showing that these particular methods are used to produce applicant's device.

Regarding applicant's argument that there is no suggestion that Bradford could be used as a document storage container: Regarding the intended use of the claimed invention "for storing documents", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The device of Bradford is fully capable of holding documents between its four sidewalls.

Regarding applicant's argument that in Bradford, the RFID tag is not captured between the glues portion of the seam: As shown in figure 8, a portion (flange 108) of the RFID tag is between the two layers of material, therefore it is considered to be captured within the seam.

Regarding applicant's argument that providing printed information on the device of Bradford teaches away from the present invention: Since information labels are removable, it does not require marking the pack in a permanent way to allow for reusing the device.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mickey Yu/
Supervisory Patent Examiner, Art
Unit 3728

/S. R./
Examiner, Art Unit 3728